

patent Application No. 051491 filed March 8, 1996. Accordingly, solely in order to reduce the issues and expedite the allowance of this application, Applicants enclose herewith a certified translation of their Japanese priority application No. 051491/1996. Therefore, this rejection is overcome.

This leaves the rejection over North, which the Examiner states teaches relevant indoline derivatives in Formula (I) at page 1, et seq. Page 1 of North teaches formula (I) and lines 5-15 provide definitions for the various moiety as thereof. In this regard, Applicants wish to respectfully point out that the number of compounds encompassed by formula (I) are on the order of ca. 7.5×10^8 .^{1/}

Accordingly, formula (I) per se is plainly inadequate as a matter of law to teach or suggest any particular compounds of the present invention. Rather, the Federal Circuit consistently held that neither genus/species

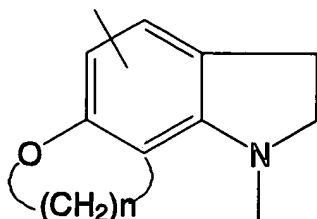
^{1/} That is $(R^1) \times (n) \times (R^2) = (68) \times (3) \times (3,672,000)$ wherein

R^1 is H or halogen or C_{1-6} alkyl = at least 34 moieties \times 2 positions = at least 68 possibilities; and

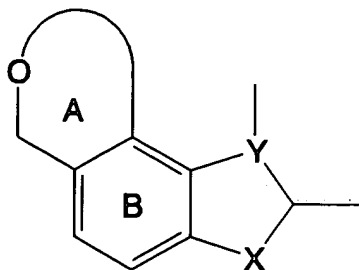
R^2 is $-\text{CR}^3\text{R}^4(\text{CH}_2)_p\text{NR}^5\text{COR}^6$ wherein R^3 , R^4 and R^5 are independently H or C_{1-6} alkyl = at least 30 moieties each = 27,000 possibilities; p is 1, 2, 3 or 4 = 4 possibilities; and R^6 is C_{1-6} alkyl or C_{3-7} cycloalkyl = at least 34 possibilities.

relationship nor common utility (or both) of the claimed and prior art compounds support a rejection for anticipation or obviousness. Rather, when the prior art, as here, discloses a "potentially infinite genus" of compounds, it is necessary to compare the pending claims only to the closest compounds that are specifically disclosed in the prior art. In re Jones, 958 F.2d 347, 350 (Fed. Cir. 1992).

Moreover, in any event, while North's formula (I) purports to teach compounds having the core structure



(see formulae (I), (1a), (II), (III), (IV), (V), (XI), (XII) and (IVa) at pages 1, 2, 8, 9, 12 and 13) the present invention instead provides a compound comprising the disparate core structure

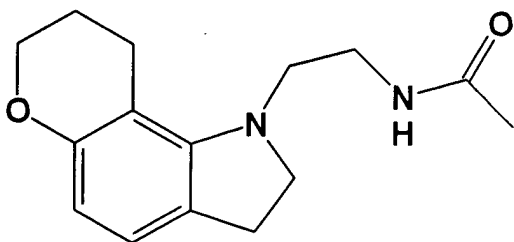


That is, the compound of present invention patentably distinguishes the genus of North's formula (I) even when Y is N, because X is CHR^4 , O or S.

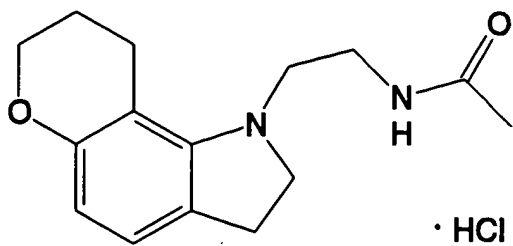
Accordingly, it is clear from the foregoing that the genus of compounds encompassed by North's formula (I) is too broad to suggest anything (In re Jones). Moreover, in any event, it is also clear that the very terms of the pending claims patentably distinguish the core structure of North's formula (I).

Nonetheless, in order to complete the record, Applicants have also compared for the Examiner's convenience the subject matter of the pending claims to each of North's Intermediates Nos. 1-22 and Examples 1-7. As the Examiner will appreciate, all of Examples 1-7 and Intermediates 1-22 in North provide that X is CH_2 , as shown below:

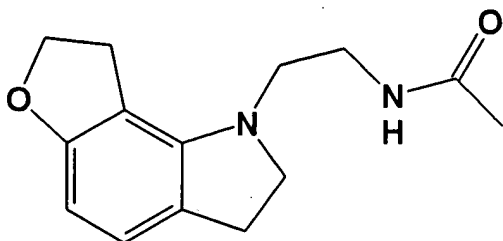
Example 1



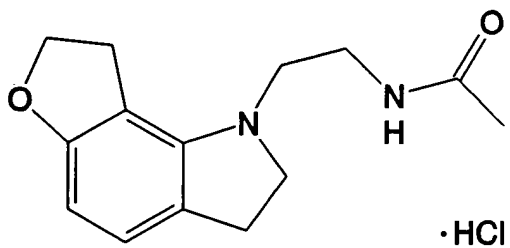
Example 2



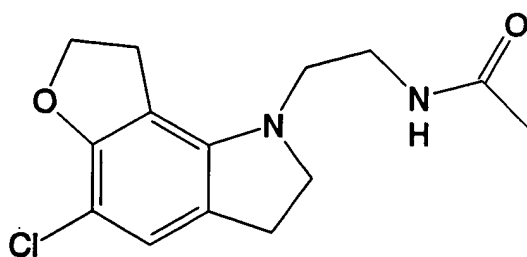
Example 3



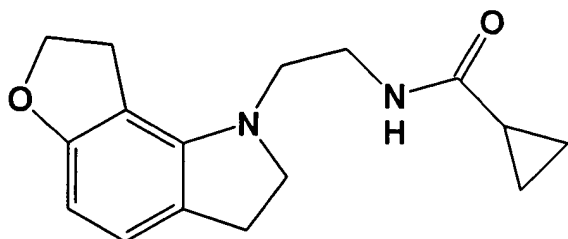
Example 4



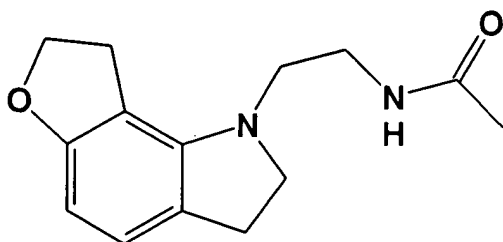
Example 5



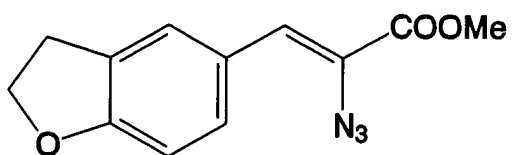
Example 6



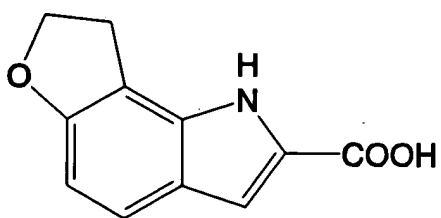
Example 7



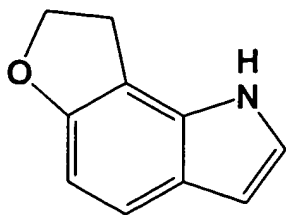
Intermediate 1



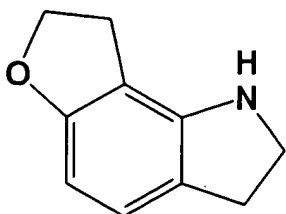
Intermediate 2



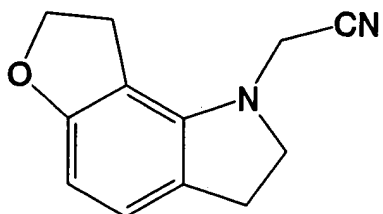
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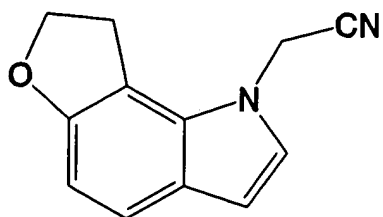
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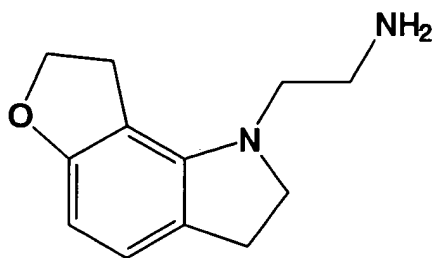
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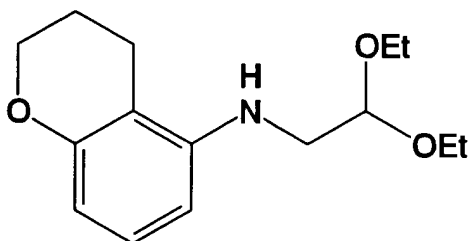
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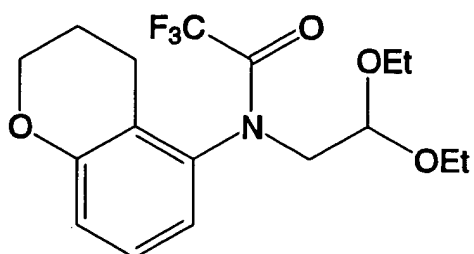
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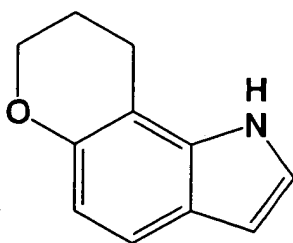
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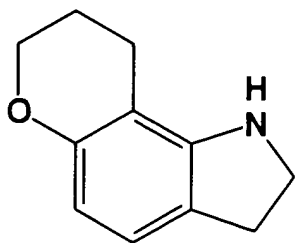
Intermediate 9



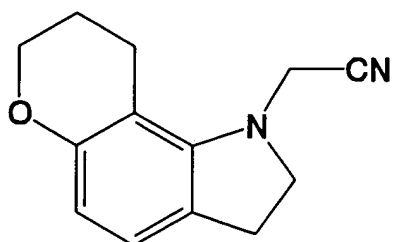
Intermediate 10



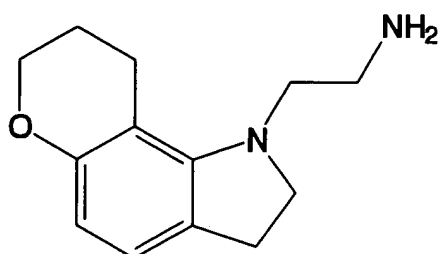
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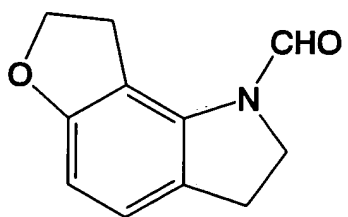
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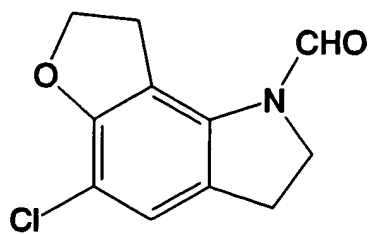
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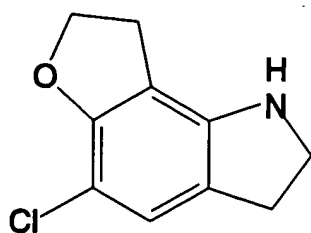
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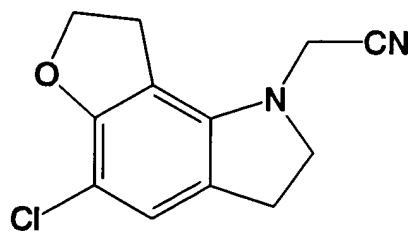
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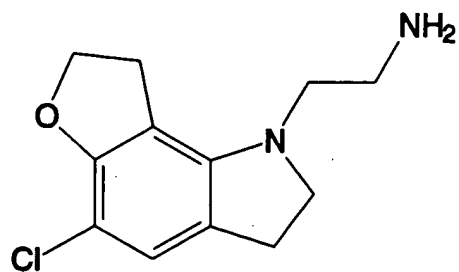
Intermediate 16



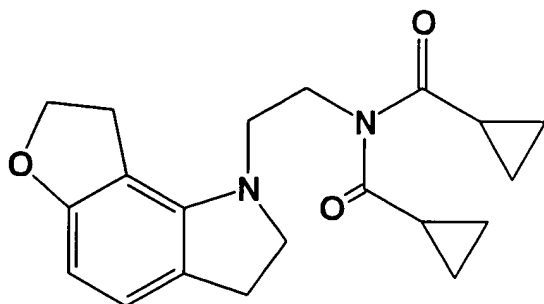
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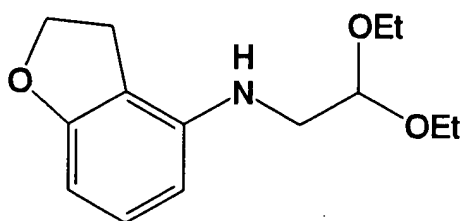
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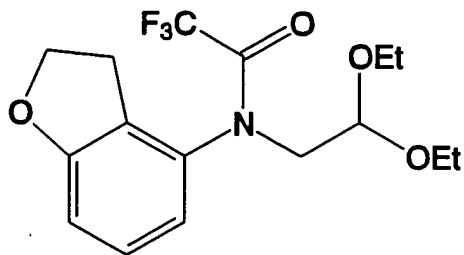
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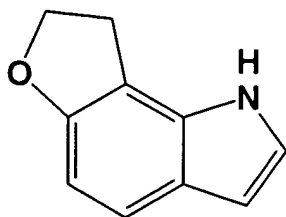
Intermediate 20



Intermediate 21



Intermediate 22



Therefore, as discussed above, these compounds also fail to teach or suggest the subject matter of the pending claims.

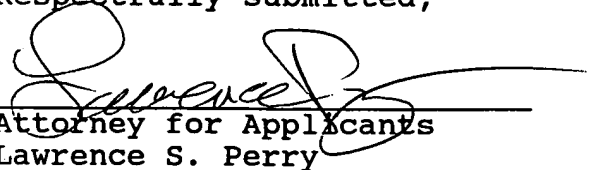
In view of the above remarks and the accompanying sworn translation, Applicants submit that all of the Examiner's concerns are now overcome and the claims are now in allowable condition. Accordingly, reconsideration and allowance of this application is earnestly solicited.

Claims 1-41 remain presented for continued prosecution.

Applicants' undersigned attorney may be reached in our New York office by telephone at (212) 218-2100. All

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Respectfully submitted,



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